

## **REMARKS**

### **Pending Claims**

Claims 1-21 and 25-33 are pending in the application. Claims 8, 15, 19, 20, 25 and 31 have been amended. Claims 22-24 were canceled by prior amendment. Claims 25-33 stand as withdrawn for being directed to a non-elected invention; however Applicants respectfully traverse the restriction of these claims for the reasons set forth below.

### **Interview Statement of Substance**

Applicants and Applicants' attorneys would like to thank the Examiner for the courtesy extended during the interview conducted on May 21, 2007. During the interview, Applicants demonstrated the advantage of the present invention over the prior art. Applicants further submitted arguments as to how the claims distinguish over cited the prior art. These arguments are set forth in detail below in the discussion of the rejection of the claims under 35 U.S.C. §§ 102 and 103. No agreement was reached as to patentability of the pending claims, although the Examiner indicated that an additional search would be required.

### **Response to Restriction Requirement**

The claims were restricted in a telephone conversation from the Examiner to Applicants' undersigned attorney on February 1, 2007, as follows:

I. Claims 1-21, drawn to a female condom, classified in class 128, subclass 830; and

II. Claims 25-33, drawn to a female condom, classified in class 128, subclass 830.

During the telephone conversation, Applicants' undersigned representative elected to prosecute claims 1-21. However, Applicants respectfully traverse the Restriction Requirement, and request reconsideration and vacation of the restriction requirement. In particular, Applicants would like to point out that independent claim 31 is directed to subject matter similar to that claimed in independent claims 1, 9 and 16.

For example, as amended, independent claim 31 includes a

pouch being constructed with a highly elastic wall so as to reside in a contracted configuration when said condom is deployed in the vagina, said pouch further being constructed to resiliently extend longitudinally from said contracted configuration to an elongated configuration when a penis is inserted into said condom,

while claim 1 includes a

pouch further being able to resiliently extend longitudinally from said contracted configuration to an elongated configuration when a penis is inserted into said condom, and said pouch including a longitudinal biasing means for returning said pouch to said contracted configuration following removal of the penis.

Independent claim 25 includes a limitation similar to that shown above for claim 31. Independent claims 9 and 16 similarly include a feature of a pouch elastically biased into a contracted configuration. Accordingly, Applicants

respectfully request that at least the independent claims, claims 25 and 31, also be examined in the next Office Action.

Further, Applicants repeat their traversal of the Restriction Requirement for the reasons set forth in the Responses to Restriction Requirement filed August 11 and March 23, 2006, and reserve their right to petition the Director to review the appropriateness of the Restriction Requirement, and further reserve their right to rejoinder of claims following allowance of any generic or linking claim. Currently claim 1 is believed to be generic.

In view of the foregoing, Applicants respectfully request that the restriction requirement be vacated and that the withdrawn claims be examined.

### **Drawings**

The drawings were objected to as failing to show every feature of the invention in the claims. In particular, it was stated that the inner pouch and outer pouch (as recited in claim 15) were not illustrated in the drawings. In response, Applicants respectfully direct the Examiner's attention to FIG. 12 which illustrates an inner pouch 705 and an outer pouch 704. Further, claim 15 has been amended in favor of an alternative embodiment, thereby rendering the objection moot. Claims 8 and 19 have been similarly amended. These amendments find support, e.g., at page 18, lines 5-7 of Applicants' specification. Accordingly, in view of the foregoing

explanation and amendment, Applicants respectfully request that the objection to the drawings be withdrawn.

**35 U.S.C. § 112**

Claim 15 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that the inner and outer pouch were not supported by the specification. In response, Applicants respectfully direct the Examiner's attention to FIG. 12 and page 19, line 13 through page 20, line 10 of the specification, which describes an embodiment having an inner and outer pouch. However, the rejection is believed to be moot in light of the amendment to claim 15, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

**35 U.S.C. §§ 102 and 103**

Claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Austin et al., US Pat. Appl. Pub. No. US2002/0038658 (hereinafter "Austin"). Claims 3-5, 9, 11-14, 16, 17-20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Austin in view of Boarman, US Pat. No. 5,113,873 (hereinafter "Boarman"). Claims 6 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Austin in view of Artisi et al., US Pat. No. 5,515,862

(hereinafter "Artisi"). Applicants respectfully traverse these rejections, and request reconsideration and withdrawal of the rejections for the following reasons.

Claim 1 is directed to a female condom including the limitation that the pouch is able to resiliently extend longitudinally from a contracted configuration to an elongated configuration when a penis is inserted into the condom, and the pouch includes a longitudinal biasing means for returning the pouch to the contracted configuration following removal of the penis. Thus, under Applicants' invention, the pouch extends when a penis is inserted during intercourse, and the pouch contracts as the penis is withdrawn. This prevents the condom from sagging out of the vagina.

Austin, on the other hand, teaches a condom having internal and/or external biasing members. In the embodiment illustrated in FIG. 14, a pair of generally U-shaped stays 73, 75 extend longitudinally along a distal pouch portion 45 and terminate at an intermediate pouch section 77 (par. 0048). Arcuate connecting portions 73c and 75c extend radially about closed end 25 to provide the stay legs with an outward biasing force tending to create a flared (badminton birdie-like) structure having a maximum diameter at the intermediate pouch section 77 (par. 0048).

Thus, the purpose of the stays 73, 75, is to exert an outward, opening force on the vaginal wall, to essentially serve to anchor Austin's condom in place and create a tenting effect. This is entirely different from Applicants' invention, in which a the condom is longitudinally biased into a contracted configuration, and is able to

resiliently extend and contract with insertion and withdrawal of a penis. The other embodiments of Austin similarly fail to teach this feature of Applicants' invention.

Accordingly, Applicants respectfully assert that claim 1 is allowable over Austin and the other art of record, whether taken singly, or in combination.

Independent claims 9 and 16 were rejected as being unpatentable in view of Austin in light of Boarman. Claim 9 includes the limitations that the pouch includes a biasing means for retaining the pouch in a longitudinally contracted configuration following deployment of the condom in the vagina, wherein the structure of the pouch allows the pouch to extend longitudinally, and exerts a contractive longitudinal bias for returning the pouch to the longitudinally contracted configuration. Claim 16 includes that the pouch includes means for elastically biasing the pouch into a contracted configuration.

As discussed above, with respect to claim 1, Austin fails to teach this feature. Further, Boarman teaches a tubular member 12 having an absorbent fluid capturing element 40 located in an distal portion 38. However, Boarman fails to teach a pouch having a structure in which the pouch can extend longitudinally and then exert an contractive longitudinal bias for returning the pouch to a contracted configuration, as recited in Applicants' claims 9 and 16. Instead, Boarman teaches that tubular container 50 is used to insert the tubular member 12 into the user's vagina, and the tubular member 12 and the container 50 therein are longitudinally displaced a predetermined distance, as determined by the length of the tubular member 12 within

the vaginal cavity (see col. 4, lines 34-42). Thus, Boarman's pouch is placed into the vagina a predetermined length, and not configured to be elastically biased into a longitudinally contracted configuration, as set forth in Claims 9 and 16. Accordingly, claims 9 and 16 are believed to be allowable over the combination of Austin and Boarman.

Withdrawn independent claims 25 and 31 include that the pouch is constructed with a highly elastic wall so as to reside in a contracted configuration when said condom is deployed in a vagina, said pouch further being constructed to resiliently extend longitudinally from said contracted configuration to an elongated configuration when a penis is inserted into said condom. For the reasons discussed above with respect to claims 1, 9 and 16, this feature is neither taught, nor suggested by Austin, Boarman, or the other art of record, whether taken singly, or in combination. Accordingly, Applicants respectfully submit that claims 25 and 31 are also allowable.

Claims 2, 20, 30 and 31 further include that the contracted configuration is the average length of a normal vaginal canal. This is substantially shorter than any other female condom taught by the references of record. Conventional female condoms are designed to be of sufficient length to accommodate a fully inserted penis. Thus, the prior art fails to teach a female condom that is designed to extend when a penis is inserted into the vagina and contract when the penis is withdrawn. Accordingly, it is respectfully asserted that these claims are also patentable over the art of record.

The remaining claims not discussed above are directed to additional patentable features of the invention, and are allowable at least because they depend from an allowable base claim.

**Conclusion**

Should the Examiner feel that additionally discussion of the invention or the prior art would be useful, the Examiner is encouraged to contact the undersigned via telephone. In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Colin D. Barnitz', with a stylized flourish at the end.

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